



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,201	07/11/2001	Eugene de Juan JR.	56247 (71699)	1217
21874	7590	06/21/2005	EXAMINER	
EDWARDS & ANGELL, LLP			DEMILLE, DANTON D	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			3764	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

## Office Action Summary

Application No.

09/904,201

Applicant(s)

JUAN ET AL

Examiner

Danton DeMille

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 15-20 is/are allowed.
- 6) ☒ Claim(s) 10-14, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*Claim Rejections - 35 USC § 103*

1. **Claims 10-14, 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Sahatjian and optionally further in view of Krasner.**
2. Yamada already teaches mounting the deflated lens on the moveable member 28, moving the moveable member from a first position to a second position deploying the lens, forming the intraocular lens by injecting a medium into the lens and removing the moveable member from the lens and eye.
3. Regarding the last line of the claim, it is recited that an injection device “may be” inserted into the intraocular lens to adjust the amount of optical medium in the intraocular lens. Since Yamada teaches that the gel filler 16 is self-sealing, an injection device is capable of being inserted into the intraocular lens to adjust the amount of optical medium and the gel filler 16 would seal around the injection device when inserted and seal when removed. Therefore it would appear Yamada teaches the last line limitation claimed.
4. The only difference between the claim and Yamada is the provision of an outer member in which to surround the moveable member 28 to protect the eye as well as the intraocular lens and moveable member while it is being inserted and removed from the eye. The new language appears to be merely describing the relative location of the moveable member within the outer member during insertion into the body and removal from the body.
5. Sahatjian teaches the conventional outer member 30 that contains and protects the inner inflatable moveable member during insertion into the body. It would have been obvious to one of ordinary skill in the art to modify Yamada to use a conventional separate outer sheath or tube

around the inner inflatable moveable member as taught by Sahatjian to protect the human tissue and protect and guide the inflatable member to its destination.

6. To any extent it is felt that the last line of claim 10 somehow further limits the method, Krasner teaches column 3, lines 15-19, the method of inserting an injection device in an already implanted lens for adjusting the amount of fluid within the lens after it has already been inserted in place. The self sealing gel 16 of Yamada would allow the function of re-inserting an injection device into the intraocular lens to adjust the amount of medium in the lens. It would have been obvious to one of ordinary skill in the art to further modify Yamada to re-insert an injection device in the lens to adjust the fluid in the lens as taught by Krasner to modify the optical character

7. **Claims 1-9 and 15-20 are allowable over prior art to which the examiner is aware.**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danton DeMille whose telephone number is (571) 272-4974. The examiner can normally be reached on M-Th from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson, can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

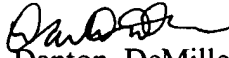
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3764

---

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20 June 2005

  
Danton DeMille  
Primary Examiner  
Art Unit 3764